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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,618	12/18/2000	James M. Barton	60097-0195	9889
29989 7590 05/14/2008 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110				
EXAMINER SHELEHEDA, JAMES R				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/740,618

Applicant(s)

BARTON, JAMES M.

Examiner

JAMES SHELEHEDA

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 14 and 16-36 is/are pending in the application.
4a) Of the above claim(s) 4, 17 and 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14, 16, 18 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 02/05/08 have been fully considered but they are not persuasive.

On page 2, of applicant's response, applicant argues that claims 30-31 were added after the election made on 02/23/07 and were therefore not subject to the restriction requirement of 01/18/07.

In response, the restriction requirement of 01/18/07, identified two separate sub-combinations usable together. One was directed to enhancing viewership during a *commercial break*, and the other was directed to creating *advertisements* with designated content portions (see applicant's specification at page 3, lines 9-19 and page 8, line 22-page 9, line 28).

The subject matter of claim 30, corresponding to withdrawn claim 28, is directed to allowing a viewer to watch an advertisement or skip to a next commercial. As this particular feature is performed by appending information into the beginning portion of ***individual advertisements*** (see applicant's specification at page 3, lines 9-19, page 8, line 22-page 9, line 28), it is withdrawn from consideration, as this is directed to the non-elected invention.

The subject matter of claim 31, corresponding to withdrawn claim 29, is directed to presenting a *second* teaser to the viewer and pausing playing the program while after displaying the *second* teaser. As this particular feature is also performed by appending

information into the beginning portion of ***individual advertisements*** (see applicant's specification at page 3, lines 9-19 and page 8, line 22-page 9, line 28), it is withdrawn from consideration, as this is directed to the non-elected invention.

Applicant argues that Zigmond interrupts the video programming, displays an advertisement and then displays the video feed, and thus, does not disclose designating a beginning portion of a commercial break in a program segment.

In response, Zigmond discloses wherein the system will *determine* an appropriate time within the video stream to insert advertisements, interrupt the video programming to output the ads and then resume outputting the video programming (column 16, lines 30-44).

Thus, during the video program, Zigmond will identify and mark a location for a commercial break within the program segment. Output of the program segment is then pause for the commercial break to occur. Once the commercial break is complete, the program resumes.

This clearly meets the claim limitations, as the claim calls for designating a beginning portion of a commercial break in a program segment. As the very definition of "designating" is to "indicate, mark or point out", Zigmond clearly meets the claim limitations. During receipt and output of the video program, Zigmond will *identify and mark* a particular position as the beginning of a commercial break in the program (column 16, lines 31-42).

Thus, applicants arguments are not convincing, as Zigmond clearly discloses a **designation** of a beginning portion of a commercial break in the program segment. The user system of Zigmond indicates the particular location within the program segment where the commercial break will occur (column 16, lines 30-43) and further indicates what commercials are to be displayed during that break (column 11, lines 31-49).

Applicant argues that Zigmond discloses displaying advertisement after the video feed is interrupted, and thus the commercial break is not part of the *original video feed*.

In response, it is noted that the claims not recite any requirement as to where the designation of the beginning portion of a commercial break occur. Zigmond discloses receiving a video stream, pausing the stream at a designated point and then inserting selected advertisements into the output video signal. Thus, Zigmond is designating a commercial break, and the corresponding commercials, within the program.

As the claims merely require designating a beginning portion of a commercial break in a program segment, Zigmond clearly meets all the claim limitations. Zigmond designates a commercial break within the received program segment. The claims do not require that the "original" video feed include the designated commercial break prior to transmission to the user's receiver.

In response to applicant's arguments concerning pausing the program segment, it is noted that Zigmond discloses wherein the received program is paused from the

beginning of the commercial break until the break ends the program is then resumed (column 16, lines 30-43). Furthermore, Zigmond discloses wherein the commercial break will include a beginning portion "teaser" with a menu of several programs (column 16, line 65-column 17, line 9). Thus, Zigmond clearly discloses pausing the received program segment before, during and after displaying the teaser, as the received program segment is paused through the commercial break.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 14, 16, 18 and 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al. (Zigmond) (6,698,020) (of record).

As to claim 1, Zigmond discloses a process for enhancing viewership of television advertisements (Fig. 5, column 1, lines 23-43), comprising:

designating a beginning portion of a commercial break in a program segment (column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is of a particular length of time (wherein the user has a predetermined time to select an ad before a default is chosen; column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is authored to provide a teaser to entice a viewer to watch commercials during the commercial break (column 16, line 65-column 17, line 9) before the viewer causes a digital video recorder (DVR) to skip through the commercial break (provided at the initiation of the commercial break; column 16, lines 30-43 and column 16, line 65-column 17, line 9); and

pausing playing of the program segment, by the DVR, after displaying the teaser (column 16, lines 30-43).

As to claim 2, Zigmond discloses wherein the teaser is a set of images that indicate a commercial relating to a particular advertisement is present (displaying of video images corresponding to the particular ad to allow the viewer to determine the ad of greatest interest; column 16, line 65-column 17, line 9).

As to claim 3, Zigmond discloses wherein the teaser is a short sequence of animations (column 16, line 65-column 17, line 9 and column 9, lines 9-20).

As to claim 14, Zigmond discloses wherein the teaser is a menu (column 16, line 65-column 17, line 9) and the viewer is allowed to select a particular item in the menu (column 16, line 65-column 17, line 9).

As to claim 16, Zigmond discloses a process for enhancing viewership of television advertisements (Fig. 5, column 1, lines 23-43), comprising the steps of:

designating a beginning portion of a commercial break in a program segment (column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is of a particular length of time (column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is authored to cause a DVR to display a menu to a viewer (column 16, line 65-column 17, line 9) before the viewer causes the DVR to skip through the commercial break (provided at the initiation of the commercial break; column 16, lines 30-43 and column 16, line 65-column 17, line 9);

pausing playing the program segment, by the DVR, while displaying the teaser (column 16, lines 30-43); and

wherein the viewer is allowed to select a particular item via the menu (column 16, line 65-column 17, line 9).

As to claim 18, Zigmond disclose wherein the teaser is a tag that triggers the DVR to display a menu (code pausing the program and initiating ad menu display; column 16, lines 30-43 and column 16, line 65-column 17, line 9).

As to claim 32, Zigmond discloses a process for enhancing viewership of television advertisements (Fig. 5, column 1, lines 23-43), comprising:

designating a beginning portion of a commercial break in a program segment (column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is of a particular length of time (wherein the user has a predetermined time to select an ad before a default is chosen; column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is authored to provide a teaser to entice a viewer to watch commercials during the commercial break (column 16, line 65-column 17, line 9); and

pausing playing of the program segment after displaying the teaser (column 16, lines 30-43).

As to claim 33, Zigmond discloses wherein the teaser is a set of images that indicate a commercial relating to a particular advertisement is present (displaying of video images corresponding to the particular ad to allow the viewer to determine the ad of greatest interest; column 16, line 65-column 17, line 9).

As to claim 34, Zigmond discloses wherein the teaser is a short sequence of animations (column 16, line 65-column 17, line 9 and column 9, lines 9-20).

As to claim 35, Zigmond discloses wherein the teaser is a menu (column 16, line 65-column 17, line 9) and the viewer is allowed to select a particular item in the menu (column 16, line 65-column 17, line 9).

As to claim 36, Zigmond disclose wherein the teaser is a tag that triggers displaying of a menu (code pausing the program and initiating ad menu display; column 16, lines 30-43 and column 16, line 65-column 17, line 9).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Art Unit: 2623

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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(Date)

Typed or printed name of person signing this certificate:

Signature: _____

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Sheleheda
Examiner, Art Unit 2623

JS

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2623